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REMARKS

Claims 1-33 are currently pending in the subject application and are presently under consideration. A clean version of all pending claims is found at pages 2-10. Applicants' representative acknowledges with appreciation the Examiner indicating claims 15-17, and 28 as being allowable if recast in independent form to include all limitations of the base claim and any intervening claims. It is believed such amendments are not necessary in view of the below-noted deficiencies of the cited references *vis a vis* the claimed invention. However, applicants' representative reserves the option to amend such claims into independent form at a later date, if necessary. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-14, 20-27, and 30-33 Under 35 U.S.C. §102(b)

Claims 1-14, 20-27, and 30-33 stand rejected under 35 U.S.C. §102(b) as being anticipated by Barker *et al.* (U.S. 4,739,477). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Barker *et al.* does not teach or suggest each and every element of the claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

The subject invention relates to dynamic pagination of electronic documents, wherein electronic documents are dynamically paginated at display time such that page break locations are determined for a particular display device. (See pg. 12, ln. 1-18; pg. 7, ln. 15-21). Thus, according to an aspect of the subject invention, the document is not paginated until the time of display. On the contrary, Barker *et al.* utilizes static pagination where page break locations are determined while creating or after editing a document (see col. 12, ln. 1-67), and not at the time of display based on the characteristics of the display device.

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The subject invention utilizes an electronic document that is partitioned into a *plurality of segments*. (See pg. 8, ln. 14-15). More particularly, independent claim 1 (and similarly independent claims 6, 20, and 30) recites processing a document of at least text as a *plurality of segments*. The Advisory Action contends that "Barker teaches the editing of a document, which is made up of segments such as paragraphs, pages, etc." (See Advisory Action dated Feb. 2, 2004, pg. 2). Even though Barker *et al.* discloses that the document can comprise paragraphs and pages, Barker *et al.* does not teach or suggest that the document comprises a *plurality of segments* as recited in the subject claims. The specification notes that "[e]ach segment ... desirably corresponds to a meaningful partition of the document 100. For example, where the document 100 is an electronic book, each segment can correspond to a chapter within the book. As a further example, where the document 100 is an electronic magazine, each segment can correspond to an article within the magazine." (See pg. 7, ln. 3-8). It is noted that the applicant can be his own lexicographer.

Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

Barker *et al.* fails to teach or suggest that the document comprises a *plurality of segments* as recited in applicants' claimed invention.

Moreover, Barker *et al.* does not teach or suggest *processing and/or entering and/or pouring a predetermined segment of the document* as recited in independent claims 1, 6, 12, 20, 23, 26, and 30. Furthermore, Barker *et al.* does not teach or suggest *determining a plurality of page breaks within a predetermined segment* as recited in independent claims 1, 6, 20, 23, and 30 or *pouring text of the segment* into a series of predetermined slots as recited by independent claims 12 and 26. Barker *et al.* discloses

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that when a need for changing a page break location is found, the document is subject to pagination on "the current page and the succeeding pages as necessary." (See col. 14, ln. 48-50; col. 12, ln. 18-43; col. 14, ln. 46-54). The Examiner states that Barker *et al.* teaches that "[i]f the editing causes a portion of the document to be moved or reflowed onto the next page, then the pages in the rest of the document from that point -- predetermined segment -- is repaginated or plurality of page breaks determined on the rest of the document." (See Advisory Action dated Feb. 2, 2004, pg. 2). This statement further illustrates the differences between applicants' claimed invention and the prior art, since Barker *et al.* discloses that page breaks are not determined for a *predetermined segment* of the document. Instead, Barker *et al.* discloses that after editing, the "rest of the document from that point forward is dynamically broken up or formatted into several pages." (See Final Office Action dated August 28, 2003, pg. 6). Thus, Barker *et al.* teaches pagination of an entire document and/or remainder of a document rather than pagination of a *predetermined segment* as in applicants' claimed invention. Additionally, Barker *et al.* is silent regarding *pouring text of the segment* as recited in applicants' claims. The subject invention employs *pouring* to determine an amount of text that will fit onto each page within a predetermined section of an electronic document to facilitate dynamical pagination. (See pg. 10, ln. 14-17). Applicants' invention, by only entering one predetermined segment into memory at a given time and only paginating the one predetermined segment into pages, conserves memory and reduces processing time. (See pg. 8, ln. 20 -- pg. 9, ln. 3).

In view of at least the above, it is readily apparent that Barker *et al.* does not anticipate or suggest the subject invention as recited in claims 1, 6, 12, 20, 23, 26, and 30 (and claims 2-5, 7-11, 12-14, 21-22, 24-25, 27, and 31-33 which respectively depend there from). This rejection should be withdrawn.

## **II. Rejection of Claims 18, 19, and 29 Under 35 U.S.C. §103(a)**

Claims 18, 19, and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barker *et al.* (U.S. 4,739,477), in view of Chirokas *et al.* (U.S. 5,111,397). It is submitted that this rejection should be withdrawn for at least the

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following reasons. *Barker et al.* and *Chirokas et al.*, alone and/or in combination, fail to teach or suggest every limitation set forth in the subject claims.

As discussed *supra*, *Barker et al.* does not anticipate or suggest all of the limitations of independent claims 12 and 26, from which claims 18, 19, and 29 respectively depend. *Chirokas et al.* does not make up for these deficiencies of *Barker et al.* Accordingly, this rejection should be withdrawn.


### III. Conclusion

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

In the event any additional fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,  
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